



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No.: 4717

Akihiro DENDA et al.

Art Unit: 2166

Application No.: 10/058,788

Examiner: M. Ali

Filed: January 30, 2002

Docket No.: 107156-00094

For: INFORMATION RECORDING AND REPRODUCING APPARATUS, METHOD
OF APPENDING TITLE INFORMATION, AND PROGRAM RECORDING
MEDIUM HAVING RECORDED TITLE INFORMATION APPENDING
PROCEDURE PROGRAM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

November 3, 2006

Sir:

The Applicants respectfully submit that the Office Action dated August 3, 2006, is both factually and legally incorrect for the reasons outlined below, as clearly explained in the Response filed August 15, 2005, and during the personal interview conducted on August 3, 2006. This Pre-Appeal Brief Request is being filed with a Notice of Appeal. No amendments are being filed herewith.

REMARKS

Claims 1-10 are pending in this application. The Office Action is a Final Office Action. Therefore, this application qualifies for Appeal.

The August 3, 2006 Office Action rejects claims 1-10 under 35 USC § 103(a) over Matsumi et al. (U.S. Patent No. 6,711,343) in view of Fujinami et al. (U.S. Patent No. 6,385,152). In making this rejection, the Patent Office asserts that Matsumi

discloses an information recording and reproducing apparatus that includes a first recording unit and control means for searching for title information through a second recording unit, wherein the title information comprises at least one of disc title, name of artist, year of sale of disc, track title and the artist for respective tracks, as recited in independent claims 1, 5 and 8. The Patent Office also asserts that Fujinami cures deficiencies in Matsumi in disclosing information supplied via a communication network.

The Office Action maintains the rejection of the claims on the grounds that, although some of the claimed features are not explicitly disclosed in the applied references, the features are encompassed or implicitly disclosed in the applied references. Moreover, the Patent Office maintains that Matsumi teaches in Fig. 32 that the title information comprises at least one of disc title, the name of an artist, genre, the year of sale of disc track and the artist for the respective tracks (Office Action, page 4, line 3). Applicants respectfully traverse these grounds for rejection for at least the reasons discussed below.

First, as discussed during the May 3, 2006, personal interview, both Matsumi and Fujinami fail to disclose searching the title information prerecorded in the second recording unit when program information reproduced from an information recording medium is recorded into the first recording unit. Matsumi's control means merely performs the function of validating the operation signal output from the operation means and disregards a command signal when receiving an operation means valid signal (Col. 48, lines 24-30). Thus, the control means invalidates the operation signal output from the operation means and uses the command signal when receiving an operation means invalid signal. Matsumi also teaches in Figs. 12A-12C that the data is written on the

tape prior to the writing or recording of file system information A (Col. 27, lines 16-28). However, as also shown in Figs. 12A-12C, either file system information A or file system information B are appended to the end of the data. As such, each of these two file systems must be recorded on the tape after the data or the append-recorded data. Thus, Matsumi fails to disclose or suggest a second recording unit for recording title information corresponding to said program information prior to recording said program information, as recited in independent claims 1, 5 and 8. Independent claims 1, 5 and 8 recite at least "searching through a second recording unit based on management information obtained," the second recording unit being "provided in said recording device for recording title information corresponding to . . . program information prior to recording [the] program information." The title information is "appended" to the program information once it is found to be recorded into the first recording unit. Even assuming, without admitting, that Matsumi teaches that part of the file system information may be recorded in the additional recording medium 113, because the file system information includes the file size in minutes and the recording start position in time code, the file system information recorded in the additional recording medium 113 must also be recorded after the data is recorded, not prior, as required by independent claims 1, 5 and 8.

The Patent Office also asserts that Matsumi teaches the function of searching through the second recording unit for the title information and refers to Col. 25, lines 6-10 and Col. 27, lines 30-34 of Matsumi. However, a closer examination of Matsumi reveals that Matsumi merely teaches searching the file system information A or B, as indicated in Figs. 6, 7, 12C, 16B and 17, and the title information found in the search is

not appended to the program information (Col. 24, lines 4-10). Matsumi merely teaches appending a valid file system information after the last program or data file is recorded. There is no teaching or suggestion in Matsumi that the title information is appended to each individual data file, as recited in independent claims 1, 5 and 8.

Second, the Patent Office also alleges that Matsumi teaches that the title information includes at least one of disc title, the name of an artist, genre, the year of sale of the disc, track title and the artist for respective tracks, and points to Fig. 32 (December 16, 2005 Office Action, page 5, lines 9-11). However, a closer examination of Matsumi and, specifically, Fig. 32, reveals that Fig. 32 is a block diagram showing the configuration of a computer and that includes a processor 251, a memory 252, a bus 253, several interfaces 254 and 255, a hard disk 257, a reception command 263, and a writing command 264 (Col. 42, lines 24-36). Accordingly, it is clear that Matsumi merely teaches a computer configuration and fails to teach that the title information comprises at least one of disk title, the name of an artist, genre, the year of sale of the track, track title, and the artist for respective tracks, as recited in independent claims 1, 5 and 8.

Even assuming, without admitting, that Matsumi teaches in Fig. 32 that the file information may include file name, file size, recording start position and title recorded data, as admitted by the Examiner during the July 20, 2005, personal interview, Matsumi fails to teach or suggest that the title information includes the above-described features of the independent claims.

In conclusion, Matsumi fails to disclose or suggest at least the claimed features of "appending the title information," which indicates either the presence or the absence of title information prior to recording program information, the "title information

includ[ing] disk title, name of artist, genre, year of sale of disk, track title or the artists for the respective tracks," as recited in independent claims 1, 5 and 8. Thus, independent claims 1, 5 and 8, and their dependent claims, are patentable over Matsumi.

Fujinami teaches a method to prevent new data from being written over already recorded data by mistake (Abstract), and fails to cure deficiencies in Matsumi in disclosing or rendering obvious the features of independent claims 1, 5 and 8. Thus, independent claims 1, 5 and 8, and their dependent claims, are patentable over the applied references, and the Office Action is factually and legally incorrect.

For at least the reasons discussed above, a pre-Appeal review of the outstanding Office Action is respectfully requested, and prompt allowance of all the pending claims is earnestly solicited.

In the event this paper is not considered to be timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel, Deposit Account No. 01-2300, referencing attorney document number 107156-00094.

Respectfully submitted,



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